

Appl. No. 10/767,981  
Amendment dated February 10, 2006  
Reply to Office Action of November 16, 2005

### REMARKS

Favorable reconsideration is respectfully requested in light of the above amendments and the following comments. Claims 21 and 22 have been amended to more particularly define the invention. Corresponding amendments have been made to claims 19, 20 and 23. Claims 34-38 have been canceled without prejudice to pursuit in a subsequent application. No new matter has been added as a result of these amendments. Favorable reconsideration is respectfully requested.

Applicants respectfully traverse the Examiner's rejection of claims 19-38 under 35 U.S.C. §103(a) as unpatentable over Agro et al., U.S. Patent No. 5,921,971, in view of Agro et al., U.S. Patent No. 6,007,522, Agro et al., U.S. Patent No. 6,152,910, and Agro et al., WO 98/10820, in view of Agro et al., WO 98/10821, Carrillo et al., WO 01/66178, and Windheuser et al., WO 00/69500, and further in view of Crittenden et al., U.S. Patent No. 4,988,356.

It is noted that several of these references are actually duplicative. For example, 6,152,910 is a continuation of 5,921,971 and WO 98/10820 appears to be the corresponding PCT publication. Similarly, WO 98/10821 appears to be a PCT publication corresponding to 6,007,522. Thus, it is not entirely clear how the Examiner is relying upon these references in forming the present rejection. If the present rejection is maintained, clarification is respectfully requested.

One of the requirements of a *prima facie* obviousness rejection is that the cited combination of references discloses each and every claimed element. At a minimum, this requirement has not been met in this case.

As amended, independent claim 21 recites a catheter that includes a guidewire lumen and an extended opening into the guidewire lumen. The guidewire lumen and the extended opening combined define a channel that has a U-shaped profile along a first portion and a C-shaped profile along a second portion. Similarly, independent claim 22 has been amended to recite a catheter having a channel providing access to a guidewire lumen, the channel having a U-shaped profile along a first portion and a C-shaped profile along a second portion.

None of the references cited by the Examiner describe or suggest, either individually or in combination, a catheter having a channel that includes a portion having a U-shaped profile and a portion having a C-shaped profile. The Examiner has asserted that "...the essence of the invention is the relationship of the gap size versus the diameter of the guidewire." While this

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may indeed be a consideration in certain aspects of the invention, this assertion does not provide a proper *prima facie* obviousness rejection.

Applicants disagree with the Examiner's assertion that it would be obvious to modify the apparatus shown by the primary reference "...with a channel that is c-shaped, u-shaped, or a combination thereof, in view of the conventionality of these enhancements." This is not correct. The Examiner has cited secondary references that include C-shaped channels. The Examiner has cited secondary references that include U-shaped channels. The Examiner has not, however, cited any reference that shows, suggests or teaches the use of both, in combination. Indeed, the only apparent suggestion to do so is found in the current application, and thus appears to qualify as reconstructive hindsight. This is not proper.

Moreover, if the invention represents mere conventionality, as the Examiner has suggested, Applicants respectfully invite the Examiner to provide a reference that actually discloses this claimed limitation. In the meantime, the Examiner has failed to provide a combination of references that disclose each and every claimed element. The Examiner has not provided any reasonable motivation to modify the teachings of the many cited references to provide a channel having a C-shaped portion and a U-shaped portion in a single catheter.

Thus, for at least these reasons, the *prima facie* obviousness rejection is flawed and should be withdrawn. Favorable reconsideration is respectfully requested.

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Reexamination and reconsideration are respectfully requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

Kevin Richardson et al.

By their Attorney,

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